REMARKS

I. Administrative Overview

Claims 1–3, 5, 6, 8, 9, 11, 12, and 14–16 were presented for examination. In the Office action mailed on December 3, 2003, the claims are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,447,565 to Daswani et al. ("*Daswani*"), U.S. Patent No. 6,141,005 to Hetherington et al. ("*Hetherington*"), and U.S. Patent No. 6,466,203 to Van Ee ("*Van Ee*"). Applicants traverse the rejections and respectfully request reconsideration.

The application generally relates to using, and tools and methods for generating on a computer, interactive control software objects that operate on handheld computing devices to provide interactive graphical human-machine interfaces that are useful for controlling parameters of processes.

II. Independent Claims 1 and 8 are Not Obvious Over *Daswani, Hetherington,* and *Van Ee*

Independent claim 1 recites, in part:

> (d) simulating on the computer the operation of the interactive control software object on the handheld portable computing device.

Independent Claim 8 recites, in part:

> (b) a module that operates on the computer to simulate the operation of the interactive control software object on the handheld portable computing device.

As the action indicates, neither *Daswani* nor *Hetherington* describes such simulation. The action suggests that *Van Ee* cures this deficiency. Applicants disagree.

> *Van Ee* describes
>
> a graphical user interface touch screen for displaying controllable functions of an electronic device. The function is displayed as an icon and at a scale size in which the function is recognizable by a user but too small to easily access features of the

function. A magnified version of at least an area of the icon is provided upon the user touching the area of the icon.

Col. 2, lns. 2–8. *Van Ee* utilizes the word "simulation," but only as part of defining the term "animation." That is,

> "[u]ser interaction with the touch screen 104 causes display 102 to undergo a change in appearance. The change is preferably effected through animation. Animation is the simulation of movement created by displaying a series of pictures, or frames, e.g., bitmaps."

Col. 4, lns. 20–25. Simulating movement on the screen of a handheld device is not "simulating on the computer the operation of the interactive control software object on the handheld portable computing device".

At least because *Van Ee* does not cure the simulation deficiency of *Daswani* and *Hetherington*, no combination of the three references could have taught or suggested all elements of independent claims 1 and 8. Applicants submit that independent claims 1 and 8 are patentable over the combination of the cited references. As claims 2, 3, 5, and 6 and 9, 11, and 12 depend from independent claims 1 and 8 respectively, the Applicants submit that claims 2, 3, 5, 6, 9, 11, and 12 also are patentable.

Even if *Vane Ee* did cure this deficiency of *Daswani* and *Hetherington*, the portions of *Van Ee* related to animation/simulation are not prior art to the present application. The present application was filed on January 6, 2000. *Van Ee*, filed on July 19, 2000., is a continuation-in-part of U.S. Patent Application No. 09/062,364, which was filed on April 17, 1998. This parent application has since issued as U.S. Patent No. 6,211,856 ("the '856 patent") (a copy of which is enclosed for convenience). Any matter in *Van Ee* not first disclosed in the '856 patent is only entitled to a priority date of July 19, 2000, which is more than six months after the present application was filed (and eighteen months after the priority date of the present application).

The '856 patent makes no mention of the animation or simulation cited against the present application. Therefore, the animation/simulation description in *Van Ee* was new matter in the continuation-in-part and should only be accorded the July 19, 2000, filing date. This description thus cannot be used as prior art against the present application.

III. Independent Claim 14 is Not Obvious Over *Daswani, Hetherington,* and *Van Ee*

Daswani, Hetherington, and the '856 patent[1] cannot properly be combined to teach or suggest all the elements of independent claim 14 of the present application. Independent claim 14 recites the provision and operation of an interactive control software object on a handheld portable computing device to provide an interactive graphical human-machine interface. An example of an interactive control software object is an ActiveX control object. Specification at page 22. Independent claim 14 further recites that the provided and operated interactive control software object was generated on a computer and that the interactive graphical human-machine interface is used to control a parameter of a process.

The only thing that *Daswani* describes as being generated on a computer and later being used by a handheld portable computing device is an "information record." Col. 3, lns. 11–12. *Daswani* describes a system wherein "Internet-based data [are] accessed, restructured, and then transmitted to a wide variety of network-capable appliances…in a form that the receiving device may display using an existing application on the device." Col. 5, lines. 5–10. *Daswani's* information records do not operate. The information records are only displayed. Col. 5, lns. 8–10. Therefore, *Daswani's* information records could not provide an interactive graphical human-machine interface when operating on a handheld portable computing device.

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[1] As asserted above, material in *Van Ee* not first disclosed in the '856 patent cannot properly be used as prior art against the present application. Therefore, the applicants address the examiner's rejection as if it was based on the '856 patent.

The '856 patent may describe a graphical interface, but it fails to disclose how that interface is implemented. The '856 patent does not describe its interface as being the result of the operation of an interactive control software object. The '856 patent also fails to describe on what device or entity that interface is generated. Therefore, like *Daswani*, the '856 patent fails to teach or suggest providing or operating an interactive control software object, generated on a computer, that provides an interactive graphical human-machine interface when operating on a handheld portable computing device.

Hetherington does not teach or suggest the use of a handheld portable computing device, at all.

In order for an obviousness rejection based on a combination of references to be proper, there must be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Applicants submit that no such teaching, suggestion, or motivation exists to combine *Daswani*, *Hetherington*, and the '856 patent.

None of the references teaches, suggests, or provides motivation for such a combination. *Daswani*, in fact, teaches away from a combination with *Hetherington*, and *Hetherington* provides no motivation or suggestion otherwise. *Hetherington* describes a system developed using JAVA™ applets, col. 8 lns. 25–32, that operate on "an endpoint computer [that] preferably includes a Web browser such as Netscape Navigator or Microsoft Internet Explorer." *Daswani's* system "transforms [a] record from the first form to a second form specific to an application other than an Internet browser." Col. 3, lns. 19–21. According to *Daswani*, "HTML or XML-scripted content is largely unsuitable for transmission...to small portable devices." Col. 2, lns 14–16. Since *Daswani* teaches away from using a browser and *Hetherington* encourages the use

of a browser, one of ordinary skill would not have been motivated to combine these two references.

For similar reasons, the combination of *Daswani* and *Hetherington* would improperly make the prior art unsatisfactory for its intended purpose. The purpose of *Daswani* is, at least in part, to provide an alternative format of Internet navigation for computing devices that suffer from "having lower memory and operat[e] under lower bandwidth resources." Col. 2, lns. 15–19. Combining *Daswani* with *Hetherington* to provide for the downloading of JAVA™ applets to a handheld portable computing device would require either higher bandwidth communications or longer downloading times. Limited memory capacity would also be an issue. Therefore, a combination of *Hetherington* and *Daswani* would be unsatisfactory for the intended purpose of *Daswani*.

Furthermore, one skilled in the art would not have been motivated to combine the '856 patent with either *Daswani* or *Hetherington* as the '856 patent is not in an analogous field of art as the other references. The '856 patent relates to remote control devices for consumer electronics components. In contrast, *Daswani* and *Hetherington* generally relate to computer network communications.
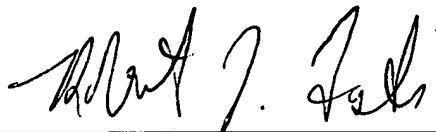
Neither *Daswani*, *Hetherington*, nor the '856 patent, individually, teach or suggest all elements independent claim 14, nor are the references properly combinable to make independent claim 14 obvious. Therefore, independent claim 14 is not obvious over *Daswani*, *Hetherington* and the '856 patent. Since claims 15 and 16 depend from amended independent claim 14, Applicants submit that claims 14-16 are patentable.

CONCLUSION

In view of the foregoing, the Applicants submit that all of the pending claims are in condition for allowance. Accordingly, the Applicants request reconsideration, withdrawal of all grounds of rejection, and allowance of all of the pending claims in due course.

If the Examiner believes that a telephone conversation with the Applicants' attorney would be helpful in expediting the allowance of this application, the Examiner is invited to call the undersigned attorney at the number identified below.

Respectfully submitted,

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